REMARKS

The Office Action has been received and carefully considered. The Office Action rejects claims 1-9 under 35 U.S.C. § 101 and rejects claims 1-12 under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 6,374,358 to Townsend ("Townsend"). Applicants respectfully traverse these rejections. Reconsideration of claims 1-12 is respectfully requested based on the following remarks.

I. The Rejection Under 35 U.S.C. § 101 Is Moot In View Of The Amendments Previously Submitted With Applicants' Response Of June 25, 2007

The rejection under § 101 that appears in the present Office Action is identical to the rejection under § 101 that appeared in the Office Action of August 10, 2005. Both rejections state that Applicants are "advised to imbed a computer in the body of the claims."

In response to the Office Action of August 10, 2005, Applicants amended claim 1 to recite that the method is "computer-implemented" and also to recite, in the body of claim 1, "developing, *by a computer*, the migration options" and "providing, *by a computer*, the migration options." Applicants have therefore complied with the Office Action's request "to imbed a computer in the body of the claims." The rejection of claims 1-9 is therefore moot, and Applicants respectfully request that it be withdrawn.

II. Townsend Fails To Disclose Identifying And Developing Risk Factors For Potential Components For The Legacy Enterprise

Claim 1 recites "identifying potential components for the legacy enterprise" and "developing risk factors for the potential components of the legacy enterprise." Townsend fails to disclose these features.

First, Townsend fails to disclose identifying *potential* components for a legacy enterprise, as claimed. Townsend is concerned with "selecting a *security model* for an organization operating an application on the organization's computer network" rather than changing a legacy enterprise. *See* Townsend, Abstract (emphasis added). Townsend does not teach, suggest, consider or disclose adding components to a legacy enterprise. Consequently, Townsend cannot teach, suggest, consider or disclose "identifying potential components for the legacy enterprise" as claimed.

At most, Townsend recites that a "Rule Base B" may include "rules for including or excluding various operating system services, such as authentication modules or I/O devices." *See* Townsend, column 4, lines 23-26. However, Townsend makes clear that such rules are applied to "modules or I/O devices" that *already exist* in organization's system, rather than to *potential* components as claimed. Indeed, Townsend refers to Rule Base B as being "for detecting exception conditions." "After these parameters [including Rule Base B] are determined for the business of the organization, *each application asset in the overall system* is evaluated independently [using, *inter alia*, Rule Base B at step 175]." *See* Townsend, column 4, lines 38-40 (emphasis added); *see also* Townsend, column 7, lines 33-37 and Fig. 1, item 175. Accordingly, Townsend at most considers evaluating pre-existing "modules or I/O devices." Townsend cannot and does not disclose or suggest identifying potential components.

Even assuming, without conceding, that Townsend discloses "identifying potential components," Townsend yet fails to disclose or suggest "developing risk factors for the potential components" as claimed. Nowhere does Townsend teach, suggest, consider or disclose developing risk factors

for potential components. Indeed, it is impossible for Townsend to do so, as Townsend never considers identifying *potential* components, let alone "developing risk factors for the potential components." This limitation is completely absent from Townsend's disclosure.

Under 35 U.S.C. § 102, anticipation requires that a prior art reference disclose each and every element of the claimed invention. *In re Sun*, 31 USPQ2d 1451, 1453 (Fed. Cir. 1993) (unpublished). MPEP § 2131, quoting *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987), reinforces this principle: "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Because Townsend fails to disclose "identifying potential components for the legacy enterprise" and "developing risk factors for the potential components of the legacy enterprise," Applicants respectfully request that the rejections of the claims be withdrawn.

III. Townsend Fails To Disclose Identifying And Developing Risk Factors For Unmet Opportunities

Claim 1 recites "identifying unmet opportunities" and "developing risk factors for the unmet opportunities." The remaining independent claims contain similar limitations. Townsend fails to disclose these features.

Townsend fails to consider unmet opportunities at all, let alone risk factors for unmet opportunities. The Office Action fails to point to any disclosure in Townsend that meets these limitations. Applicants respectfully request, should the Office continue its rejection, that the Office point to the specific portion of Townsend that allegedly meets these limitations.

Under 35 U.S.C. § 102, anticipation requires that a prior art reference disclose each and every element of the claimed invention. *In re Sun*, 31 USPQ2d 1451, 1453 (Fed. Cir. 1993) (unpublished). MPEP § 2131, quoting *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987), reinforces this principle: "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Because Townsend fails to disclose "identifying unmet opportunities" and "developing risk factors for the unmet opportunities," Applicants respectfully request that the rejections of the claims be withdrawn.

IV. Townsend Fails To Disclose Developing Migration Options Using Risk Factors For Components, Unmet Opportunities And Potential Components

Claim 1 recites "developing, by a computer, the migration options with associated risks using at least the risk factors for the components, the risk factors for the unmet opportunities and the risk factors for the potential components." Townsend fails to disclose this feature.

Townsend is directed to "selecting a security model" for an organization rather than developing migration options as claimed. Townsend neither discloses - nor has any need to disclose - developing migration options in a legacy enterprise, as Townsend's concerns lie elsewhere. Moreover, Townsend fails to teach, suggest, consider or disclose developing migration options using (1) risk factors for the components, (2) risk factors for the unmet opportunities, and (3) risk factors for the potential components. Indeed, as discussed above in Section III, Townsend fails to offer any disclosure whatsoever of at least risk factors for the unmet opportunities.

Under 35 U.S.C. § 102, anticipation requires that a prior art reference disclose each and every element of the claimed invention. *In re Sun*, 31 USPQ2d 1451, 1453 (Fed. Cir. 1993) (unpublished). MPEP § 2131, quoting *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987), reinforces this principle: "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Because Townsend fails to disclose "developing, by a computer, the migration options with associated risks using at least the risk factors for the components, the risk factors for the unmet opportunities and the risk factors for the potential components," Applicants respectfully request that the rejections of the claims be withdrawn.

V. Conclusion

In view of the foregoing, it is respectfully submitted that the present application is in condition for allowance, and an early indication of the same is courteously solicited. The Examiner is respectfully requested to contact the undersigned by telephone at the below listed telephone number, in order to expedite resolution of any issues and to expedite passage of the present application to issue, if any comments, questions, or suggestions arise in connection with the present application.

Applicant believes that no fee is required for entry of the present Reply. Nevertheless, in the event that a variant exists between the amount tendered and that determined by the U.S. Patent and Trademark Office to enter this Reply or to maintain the present application pending, please charge or credit such variance to the undersigned's Deposit Account No. 50-0206.
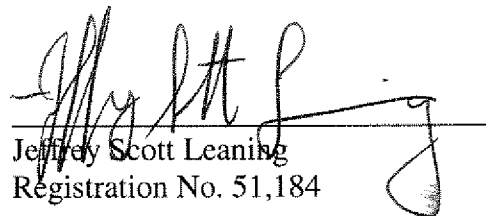
Respectfully submitted,

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